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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,359	03/16/2004	Benjamin Silberstein		3792

7590 10/31/2005
Stephen E. Feldman, P.C.
12 East 41st Street
New York, NY 10017

EXAMINER

ALLEN, WILLIAM J

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding:

Office Action Summary	Application No. 10/802,359	Applicant(s) SILBERSTEIN ET AL.	
	Examiner William J. Allen	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: In paragraph [0013], the applicant recites "The major stone may be presented to a recipient **looses** and unmounted...". Appropriate correction is required.

The spacing of the lines of the specification is such as to make reading difficult. New application papers with lines 1½ or double spaced on good quality paper are required.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The preamble of claim 1 recites a method for selling jewelry comprising multiple steps, however, the applicant has failed to include steps for selling the jewelry in the method. The body of the claim is directed to personalization of jewelry; therefore, it is unclear of the subject matter being claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over www.BlueNile.com, dated February 16, 2003, extracted October 21, 2005 from www.archive.org (herein referred to as BlueNile) in view of www.moonstone-jewelry.com/lesbian-ring-511.html, dated October 21, 2002, extracted from www.archive.org on October 24, 2005 (herein referred to as Moonstone).

BlueNile teaches a web site provided for customization of jewelry by choosing stone type, cut, setting (for rings), type of metal (gold, white gold, platinum, etc.), etc. BlueNile further includes an education section, gift ideas, recommendations, and an advanced search feature for searching for jewelry.

Regarding claim 1, BlueNile teaches *providing a rough stone*, noted as a "diamond rough". The gemologists *determine a cutting configuration for the rough stone* and the diamonds are cut into multiple stones comprising at least a first and second stone (i.e. *cutting the rough stone to provide the first and second stone*). The stones may be *presented to a first and second person* with different cuts or configurations.

BlueNile teaches all of the above and further teaches cutting a diamond rough into multiple stones to be presented to multiple customers (i.e. a first and second person). BlueNile, however, does not teach *the first and second person having a specific relationship*. Moonstone teaches a web site for selling commitment rings. The commitment rings are hand carved and fit together as one, and can be shared by a first person and a second person (e.g. life partners, engaged couples, etc.) to show commitment and express love. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the invention of BlueNile to include a first and second person having a relationship as taught by Moonstone in order to allow couples a meaningful way to express love through increasing the meaning behind the artifact (i.e. the idea of one partner "completing" another partner as shown by the two separate rings forming one complete ring). BlueNile, however, does not teach *the first and second person having a specific relationship*.

Regarding claim 2, BlueNile also provides a "Build Your Own Ring" feature that allows a recipient to choose a setting (i.e. *mounting*) in each of a selected piece of jewelry. The stones would then be mounted before shipping.

Regarding claims 3-7, BlueNile comprises a website for purchasing customized jewelry. In this instance, the reference is drawn to purchasing engagement rings (i.e. *to be married*) as opposed to rings for a life partner, parent and sibling, siblings, or husband and wife. These differences, however, are only found in the nonfunctional descriptive material and do not alter how the method functions (i.e., the descriptive

Art Unit: 3625

material does not reconfigure the display). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow persons of any type of relationship use because the type of relationship has no affect on the function of the method and because the subjective interpretation of the type of relationship does not patentably distinguish the claimed invention.

Regarding claim 8, BlueNile further teaches *presenting information to a customer outlining the process of cutting a rough stone, and options included in purchasing a rough stone including cuts and sizes*. BlueNile outlines the cutting process and shows options on a search page for selecting cuts and sizes of the stone.

Regarding claim 9, BlueNile further teaches presenting the information *over the Internet* in the form of a web page.

Regarding claims 10-13, BlueNile comprises a website for purchasing customized jewelry. In this instance, the reference is drawn to purchasing diamond rings as opposed to ruby, emerald, or sapphire rings. These differences, however, are only found in the nonfunctional descriptive material and do not alter how the method functions (i.e., the descriptive material does not reconfigure the display). Thus, this

Art Unit: 3625

descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow use of any type of stone because the type of stone has no affect on the function of the method and because the subjective interpretation of the type of stone does not patentably distinguish the claimed invention.

Regarding claim 14, BlueNile further teaches *the first stone larger than the second* stone. A diamond rough stone is presented and shown being cut into 2 separate stones. The first stone is shown to be larger than the second stone.

Regarding claims 15-20, the claim language of claims 15-20 closely parallels that of claims 1-7, therefore, claims 15-20 are analyzed and rejected by the same merits.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 20030163938 to Norton discloses a jewelry design selection system and a method allowing a user to select a setting from a number of settings and stone configurations, or allow a user to select a stone and view a number of settings. Adelman (US 20020166339) discloses a method of making jewelry including providing

Art Unit: 3625

an item to be mounted. US 20020133431 to West et al. disclose a method that enhances the atmosphere of romance that surrounds the purchase and delivery of a gift of jewelry. Press release "Wedding vow rings help couples pledge love" discloses personalized wedding bands with personally written or selected vows engraved on the inner portion of the ring. KeepSakeMugs.com, accessed October 24, 2005, discloses a split heart key chain, allowing couples to share a keychain representative of their love.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571) 272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William J. Allen

Yogesh C. Gao
Primary Examiner